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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,407	12/13/2001	Kevin P. Baker	P2830P1C61	8089
35489	7590	02/10/2005	EXAMINER	
HELLER EHRMAN WHITE & MCAULIFFE LLP			NICKOL, GARY B	
275 MIDDLEFIELD ROAD			ART UNIT	
MENLO PARK, CO 94025-3506			PAPER NUMBER	

1642

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/017,407	<b>Applicant(s)</b> BAKER ET AL.	
	<b>Examiner</b> Gary B. Nickol Ph.D.	<b>Art Unit</b> 1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 31-35, 38-40 and 44-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 31-35, 38-40 and 45-47 is/are allowed.
- 6) ☒ Claim(s) 48-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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Baker *et al.*

Earliest date of priority: 02/18/2000

***Response to Amendment***

The Amendment filed 11-12-2004 in response to the Office Action of 05-14-2004 is acknowledged and has been entered.

Claims 31-35, 38-40, and 44-54 are currently under consideration.

**The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.**

**New Objections:**

Claim 48 is objected to for reciting “consisting of an at least 20 nucleotides fragment” which renders the claim grammatically unclear.

**New Rejections:**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

New claims 48-54 are rejected under 35 U.S.C. 102(b) as being anticipated by EST Sequence Databases, Accession No. AA584408, September 26, 1997 for the reasons of record in the Action mailed 05-14-2004, page 9 and for the reasons below.

The reference teaches a human cDNA that is at least 10 nucleotides in length (Claim 43) and has 620 base pairs that has an overall match of 55.5% with SEQ ID NO:305. As set forth previously, the sequence of the prior art would inherently hybridize under stringent conditions. Applicant argues (Response, page 13-14) that the art-recognized meaning of "specific" hybridization is that the nucleic acid molecule that specifically hybridizes to a particular nucleic acid sequence without binding to another nucleic acid sequence and further add that in view of the limited degree of sequence identity (55.5%) the claims are not anticipated. These arguments have been carefully considered but are not found persuasive. The intended use of the compound must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. Currently, the prior art *is* a nucleic acid that is at least 20 nucleotides in length and *is* a fragment of SEQ ID NO:305. Thus, if the prior art structure anticipates the claimed invention than it is also capable of performing the intended use. A composition is a composition irrespective of what its intended use is. See In re

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Tuominen, 213 USPQ 89 (CCPA 1982). Thus, applicant's arguments have not been found persuasive and the rejection is maintained.

Claims 48-54 are rejected under 35 USC 112, first paragraph, as the specification does not contain a written description of the claimed invention. The limitation of at least (20, 50, 60, 70, 80, 90, and 54) nucleotides appears to have no particular support in the specification and the claims as originally filed with regards to specific numerical lengths of probes or primers.

Applicant is required to cancel the new matter in the response to this Office Action.

Alternatively, applicant is invited to provide sufficient written support for the "limitation" indicated above. See MPEP 714.02 and 2163.06

Claims 31-35, 38-40, and 44-47 appear allowable.

**All other rejections and or objections are withdrawn in view of applicant's amendments and arguments there to.**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

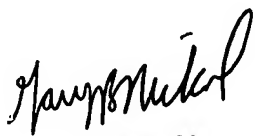
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary B. Nickol Ph.D. whose telephone number is 571-272-0835. The examiner can normally be reached on M-Th, 8:30-5:30; alternate Fri., 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gary B. Nickol Ph.D.  
Primary Examiner  
Art Unit 1642

GBN

  
**GARY NICKOL**  
**PRIMARY EXAMINER**